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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,276	12/03/2003	Brian Jones	60001.283US01	5987

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/727,276	Applicant(s) JONES ET AL.	
	Examiner Matthew J. Ludwig	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed 12/3/03.
2. Claims 1-19 are pending in the application. Claims 1, 9, and 16, are independent claims.
3. Claims 1-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ayers, "AbiWord Schema".

Information Disclosure Statement

4. The information disclosure statement filed 6/12/2006 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to independent claim 1, the claim refers to non-structured, however, it is unclear to the Examiner what is meant by a non-structured feature. Applicant states within the specification, 'that some of the features that may span arbitrary ranges include features such as comments, bookmarks, document protection, and the like'. If a comment is made with the utilization of an XML document and the utilization of a tag it would adhere to some type of structured processing and therefore could be considered a structured feature. Non-structured feature leaves the limitation inaccurate and vague at best. Furthermore, the newly added limitation '*placing a start tag at the start tag location; wherein the start tag is an empty tag that does not overlap other elements*' fails to accurately define the invention and leaves the examiner confused as to how the overlapping would occur and what 'other elements' refers to. The elements are not defined with the claim and it seems contradictory to the following limitation, '*wherein the start tag and the end tag span other tags while maintaining a well formed ML document*'. The vexatious nature of the language would leave one of ordinary skill in the art confused as to how something does not overlap something else but also has the ability to span other tags while maintaining a well formed ML document. The examiner believes the

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claim fails to particularly point out and distinctly claim the subject matter with the addition of the newly formed subject matter. Finally, Examiner suggests changing the phrase 'placing a start tag' with 'placing a start feature tag'. Applicant defines the well-known meaning of a start tag and end tag on page 5 of the specification, however, the utilization of terms 'start tag' and 'end tag' within the independent claim re-define the term recognized by those of ordinary skill in the art and state the 'start tag' is an empty tag that does not overlap other elements; and wherein the start tag and the end tag span other tags while maintaining a well formed ML document. The Examiner recommends replacing the phrase with 'placing a start feature tag' and 'placing an end feature tag' to distinguish over the well-known meaning of the term with those of ordinary skill in the art.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayers ("AbiWord's Potential"), hereafter referred to as "Ayers", in view of AbiWord Schema (www.abisource.com/awml.xsd), hereafter referred to as "AbiWord Schema".**

In reference to independent claim 1, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file which is written in XML. Ayers also discloses performing an action on the word-processor

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document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. Finally, Ayers fails to explicitly state an XSD or XML Schema definition which represents a word processor's rich formatting, and is published and available to other application for interpreting/validating the word-processor document. See AbiWord Schema, pages 1-3. Both a start tag and end tag are disclosed within the conversion of the word processor document taught by Ayers (compare to **"determining a start tag location, determining an end tag location"**). AbiWord schema discloses the location of the published XML Schema at www.w3.org/2000/10/XMLSchema and the XSD for AbiWord, published at www.abisource.com/awml/xsd (See AbiWord Schema, page 1, line 3, and trailer line, bottom of page. The claim language included within the independent claim recites the phrase 'may span other tags while maintaining a well formed ML document'. The Examiner believes the indefinite language found within the claim would leave one of ordinary skill in the art without a detailed step. If the claim includes the word may, then it merely states that it *may* or *may not* span other tags while maintaining a well formed ML document (compare to ***"placing a start tag at the start tag location and an end tag at the end tag location, wherein the start tag and the end tag may span other tags while maintaining a well formed ML document"***). It would have been obvious to one of ordinary skill in the art, having the teachings of Ayers and AbiWord Schema before him at the time the invention was made, to modify the AbiWord documents taught by Ayers to include the AbiWord XSD of AbiWord Schema because it would have given the author a proficient means of validating the AbiWord document and defined the tags within a document.

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In reference to dependent claim 2, Ayers teaches:

Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. The reference fails to explicitly state the start and end tag including an identifier that may be used to indicate an association between the start tag and the end tag; however, the AbiWord reference discloses an XSD for validating an AbiWord document. (See AbiWord Schema, pages 1-3). The reference provides a means of identifying tags and validating the document utilizing a rich formatting, including styles, lists, sections, and data types (See AbiWord Schema, page 1, lines 16-19.)

In reference to dependent claim 3, Ayers teaches:

Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. The reference fails to explicitly state the start and end tag including an identifier that may be used to indicate an association between the start tag and the end tag; however, the AbiWord reference discloses an XSD for validating an AbiWord document. (See AbiWord Schema, pages 1-3). The reference provides a means of identifying tags and validating the document utilizing a rich formatting, including styles, lists, sections, and data types (See AbiWord Schema, page 1, lines 16-19.)

In reference to dependent claim 4, Ayers teaches:

AbiWord, a word processor product that reads a word-processor document stored as a *.abw file which is written in XML. See Ayers, page 2, 3rd full paragraph.

In reference to dependent claim 5, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file which is written in XML. See Ayers, page 2, third full paragraph. The AbiWord Schema disclose an example of an empty tag on page 2 which is disclosed as a restriction base at the bottom of the page. As presently claimed, the language fails to preclude the Examiner from utilizing the restriction base as an empty tag.

In reference to dependent claim 6 & 7, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file which is written in XML. Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. Finally, Ayers fails to explicitly state an XSD or XML Schema definition which represents a word processor's rich formatting, and is published and available to other application for interpreting/validating the word-processor document. See AbiWord Schema, pages 1-3. Both a start tag and end tag are disclosed within the conversion of the word processor document taught by Ayers (compare to "**determining a start tag location, determining an end tag location**"). AbiWord schema discloses the location of the published XML Schema at www.w3.org/2000/10/XMLSchema and the XSD for AbiWord, published at www.abisource.com/awml/xsd (See AbiWord Schema, page 1, line 3, and trailer line, bottom of page. The reference provides a means of identifying tags and validating the document utilizing a rich formatting, including styles, lists, sections, and data types (See AbiWord Schema, page 1, lines 16-19.)

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In reference to dependent claim 8, Ayers teaches:

A word processor product that reads a word-processor document stored as a *.abw file which is written in XML. Ayers also discloses performing an action on the word-processor document, in the form of creating and examining an AbiWord file that recreates the word processor's set of features. See Ayers, page 3, paragraph 2. AbiWord Schema provides annotations within the XSD file and it would have been obvious to provide these features within the well-formed structured document because it would have given the author a proficient means of properly validating various functions found within a word processor document.

In reference to claims 9-15, the claims recite the computer readable medium comprising instructions for carrying out the document methods as claimed in 1-9. Therefore, the claims are rejected under similar rationale.

In reference to claims 16-19, the claims recite the system comprising instructions for carrying out the document features as claimed in 1-9. Therefore, the claims are rejected under similar rationale.

Response to Arguments

9. Applicant's arguments filed 5/30/2006 have been fully considered but they are not persuasive.

Applicant argues on page 6 of the amendment that Ayers does not disclose that the start tag and the end tag are empty tags that do not overlap other elements. The newly formed claim language fails to accurately point out what is meant by overlapping and the phrase 'other elements' falls short of an accurate description of the claim when read as a whole. Applicant states within the

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specification, 'that some of the features that may span arbitrary ranges include features such as comments, bookmarks, document protection, and the like'. If a comment were made with the utilization of an XML document it would adhere to some type of structured processing. Non-structured feature leaves the limitation inaccurate and vague at best. Furthermore, the newly added limitation '*placing a start tag at the start tag location; wherein the start tag is an empty tag that does not overlap other elements*' fails to accurately define the invention and leaves the examiner confused as to how the overlapping would occur and what 'other elements' refers to. The elements are not defined with the claim and it seems contradictory to the following limitation, '*wherein the start tag and the end tag span other tags while maintaining a well formed ML document*'. The vexatious nature of the language would leave one of ordinary skill in the art confused as to how something does not overlap something else but also has the ability to span other tags while maintaining a well formed ML document. The examiner believes the claim fails to particularly point out and distinctly claim the subject matter with the addition of the newly formed subject matter.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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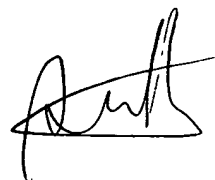
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ML



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